

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): KATO, et al.

Serial No.: 09/461,432

Filed: December 16, 1999

For: VACUUM PROCESSING APPARATUS AND OPERATING METHOD THEREFOR

Group: 3749

Examiner: S. Gravini

TECHNOLOGY CENTER 3700

SEP 7 2000

RECEIVED

**PETITION TO WITHDRAW NOTICE OF ABANDONMENT BASED
ON APPLICANTS' FAILURE TO RECEIVE NOTICE OF ALLOWANCE**

Assistant Commissioner for Patents
Washington, D.C. 20231

September 7, 2000

Sir:

Applicants' through their attorney, respectfully request that the Notice of Abandonment mailed August 14, 2000, be withdrawn, and that a new Notice of Allowance be issued in the above-identified application, with a re-set period for response (e.g., for payment of the Issue Fee) to begin from the date of mailing the new Notice of Allowance.

Note that the undersigned received a copy of the Notice of Allowance dated March 20, 2000, for the first time, by facsimile from LaTrisha N. West of the Customer Service Center, Technology Center 3700, on August 8, 2000. This Notice of Allowance dated March 20, 2000, was apparently mailed to an incorrect address for the offices of the undersigned law firm, that is, was mailed to a previous address from which the undersigned law firm had moved a number of years ago. The Notice of Abandonment in connection with the above-identified application was mailed August 14, 2000.

MATCH & RETURN

This Notice of Abandonment is the action complained of in the present Petition. Noting that the date on the Notice of Abandonment is August 14, 2000, clearly the present Petition is timely. See 37 CFR 1.181(f).

FACTS

In a telephone communication from the undersigned to Technology Center 3700, shortly prior to the above-mentioned facsimile of August 8, 2000, the undersigned contacted Technology Center 3700 to determine the status of the above-identified application. The undersigned was informed that the above-identified application had had a Notice of Allowance and Issue Fee Due mailed in connection therewith, on March 20, 2000. The undersigned requested a copy of this Notice of Allowance, which was transmitted to the undersigned as part of the above-mentioned facsimile of August 8, 2000. Shortly thereafter (on August 14, 2000), a Notice of Abandonment was issued in connection with the above-identified application, indicating that the application is abandoned in view of Applicants' failure to timely pay the required Issue Fee within the statutory period of three months from the mailing date of the Notice of Allowance. This Notice of Abandonment mailed August 14, 2000, had the correct address for the offices of the undersigned law firm. In view of this Notice of Abandonment, the present Petition has been filed.

ARGUMENTS

As will be established in the following, it is respectfully submitted that the Notice of Allowance dated March 20, 2000, was never received in the offices of the undersigned until August 8, 2000. Moreover, it is noted that the Notice of Allowance dated March 20, 2000 had an incorrect address for the offices of the undersigned, which was an error on the part of the U.S. Patent and Trademark Office in light of the fact that the Customer Number of the undersigned law firm was clearly set forth on the Utility Patent Application Transmittal for the above-identified application. Accordingly, withdrawal of the Notice of Abandonment mailed August 14, 2000, and issuance of a new Notice of Allowance in the above-identified application, with the period for payment of the Issue Fee being re-set to begin with the date of mailing the new Notice of Allowance, is clearly proper. See Delgar v. Schuyler, 172 USPQ 513 (D.D.C. 1971).

It is respectfully submitted that the following facts clearly support the conclusion that the aforementioned Notice of Allowance dated March 20, 2000 in the above-identified application, was never received in the offices of the undersigned until August 8, 2000. That this Notice of Allowance dated March 20, 2000 was never received in the offices of the undersigned until August 8, 2000, is buttressed by the fact that the U.S. Patent and Trademark Office mailed the Notice of Allowance to an incorrect address, incorrect in view of the purported procedures at the U.S. Patent and Trademark Office for use of the Customer Number and the fact

that the Customer Number for the undersigned law firm was set forth on the Utility Patent Application Transmittal for the above-identified application.

In the offices of the undersigned attorneys, all mail which is received from the U.S. Patent and Trademark Office (PTO) is given directly to a docketing department. Responsive to receipt of such mail, as a first safeguard, the docketing department personnel maintain a computer database which stores information relating to the filing of papers in the PTO, receipt of papers from the PTO, and due dates for responding to papers received from the PTO. The data in the computer database is backed up on a magnetic tape at the end of each work day.

Attached hereto (as Exhibit I) is a print-out of pertinent data in the computer database, for the above-identified application. The attached print-out shows data fields entitled, inter alia, "ACTION"; "BASE"; "DUE IN"; "DUE"; "FINAL"; and "RESPONSE".

When a paper which can be responded to, or which must be responded to in order to avoid abandonment, is received in the law firm of the undersigned from the PTO, personnel of the docketing department enter the paper in appropriate data fields. For example, in the present application, the Notice of Allowance was dated March 20, 2000; accordingly, if the Notice of Allowance had been received in the offices of the undersigned, the docketing department would have entered "ISSUE FEE" in the "ACTION" data field; "3/20/00" in the "BASE" data field; "3M" in the "DUE IN" data field; "6/20/00"

in the "DUE" data field; and "6/20/00" in the "FINAL" data field. As can be seen from the attached print-out (Exhibit I), there are no entries in connection with an Issue Fee or Notice of Allowance. This clearly shows that the Notice of Allowance as mailed March 20, 2000 was not received in the offices of the undersigned.

As a second, safety cross-check against the computer database, personnel of the aforementioned docketing department also maintain a hand-written master docket book which has one page for each day of the year. After data relating to a paper mailed from the PTO and received in the offices of the undersigned law firm has been entered into the computer database, personnel of the docketing department of the undersigned law firm hand-write data relating to such paper into the master docket book on the page corresponding to the expiration date, which cannot be extended (or cannot be extended further) under 37 CFR 1.137(a), for response to the paper. For the Notice of Allowance mailed March 20, 2000, in the above-identified application, the expiration date would have been June 20, 2000, three months after the mailing date of the Notice of Allowance and the date payment was due on the Notice of Allowance, so that hand-written data should have been entered on the page for June 20, 2000.

When the Notice of Allowance is received, the docketing department enters the following information in a master docket book, on the page corresponding to the expiration date referred to previously:

The docket number of the application to which the PTO action pertains; the last name of the first-named inventor of the application; the serial number of the application; the notation "Issue Fee"; and the initials of the attorney to whom the application is assigned.

Therefore, if the Notice of Allowance dated March 20, 2000, for the above-identified application had been received in the offices of the undersigned attorneys, the attached copy of the page of the master docket book for June 20, 2000 (Exhibit II attached hereto), would show a line with the following data:

"503.30414C14"; "KATO"; "461,432"; "Issue Fee"; and "WIS".

However, as can be seen from the attached copy of the page of the master docket book for June 20, 2000, such entry does not appear.

It is respectfully submitted that the absence of a entry in the master docket book page for June 20, 2000, for the above-identified application, evidences the fact that the Notice of Allowance mailed March 20, 2000, was never received in the offices of the undersigned law firm.

The master docket book for June 20, 2000, has an entry for payment of the Issue Fee for Serial No. 461,433 (Attorney docket no. 503.30414V15), naming the same inventors as named in the above-identified application, examined by the same Examiner that examined the above-identified application and having a Notice of Allowance dated the same date as that of the above-identified application. See Exhibit III. However, the Notice of Allowance for Serial No. 461,433 had the correct

address for the undersigned law firm, likely based upon the Customer Number (since the Declarations Under 37 CFR 1.63 in each were the same). With the correct address, the Notice of Allowance in Serial No. 461,433 was received in the offices of the undersigned and the Issue Fee timely paid. The same result would have occurred with the above-identified application, if the PTO had mailed the Notice of Allowance to the correct address.

Moreover, the undersigned hereby states that a search of the application file of the above-identified application has been made, and a Notice of Allowance dated March 20, 2000, for the above-identified application, other than the copy sent by facsimile on August 8, 2000, was not found.

All of the foregoing clearly shows that the Notice of Allowance dated March 20, 2000, for the above-identified application, was not received in the offices of the undersigned.

It is again emphasized that the Notice of Allowance dated March 20, 2000, in connection with the above-identified application was sent to an incorrect address; that is, a prior address of the offices of the undersigned law firm. While the Declaration and Power of Attorney for Patent Application filed with the above-identified application, which was an original Declaration from a prior application, had such prior address, the Utility Patent Application Transmittal for the above-identified application had the Customer Number for the undersigned law firm. Under the undersigned's understanding of proper procedures at the PTO, the PTO is supposed to

utilize the Customer Number; clearly in connection with the above-identified application the PTO did not follow such procedures. It is respectfully submitted that the mailing of the Notice of Allowance to an incorrect address arose due to errors on the part of the PTO. It is respectfully submitted that Applicants should not lose substantive rights, due to errors on the part of the PTO.

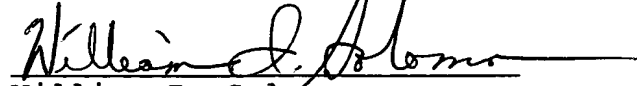
In view of all of the foregoing, it is respectfully submitted that it has been shown that the Notice of Allowance dated March 20, 2000, in the above-identified application, was never received in the offices of the undersigned, until a copy thereof was received by facsimile on August 8, 2000. Accordingly, consistent with Manual of Patent Examining Procedure 710.06 and 711.03(c), it is respectfully petitioned that the Notice of Abandonment mailed August 14, 2000, be withdrawn; that the Notice of Allowance dated March 20, 2000, be re-mailed; and that a new period for responding to the Notice of Allowance (that is, for payment of the Issue Fee) be re-set to allow Applicants to take appropriate action, based on the rationale set forth in Delgar Inc. v. Schuyler, supra.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit

Account No. 01-2135 (Case No. 503.30414C14) and please credit
any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



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WIS/slk
Enclosures

OPER: ENTERED MODIFIED ATTORNEYS / / PRINTED ON:

ATSK# CNTRY UNITED STATES NEW/CON RELATED

PATS# TYPE SERIAL# PATENT# STAT

TITLE RL/FM

CLIENT CREF SE ART

AGENT AREF CLAIMS

PRIOR MAIL FILE PUBL ISSUE EXP 10/23/18 1ST

ID	O	ACTION	BASE	DUE IN	DUE	EXTNS	FINAL	EXT	RESPONSE	CALL	1	2	P
PC	N	POST CARD CHECK	12/16/99	1M	1/16/00		1/16/00	0	12/23/99	0M	N	N	Y
	Y	SUPP PRE AMEND	2/10/00										
FS	N	FILG RCPT STATUS CHK	12/16/99	3M	3/16/00		3/16/00	0	4/6/00	0M	N	N	Y
	Y	V16 FILED	4/19/00										
	Y	COMMFROM PTO	8/8/00										
NOTICE OF ALLOWANCE DATED 3/20/00													
SC	N	STATUS CHECK	12/16/99	18M	6/16/01		6/16/01	0		1M	Y	Y	Y

PRIOR APPLICATIONS						
REFERENCE#	CNTRY	SERIAL#	FILED	TITLE / DESCRIPTION	TYPE	
503.30414C10	US	177,495	1/29/99	VACUUM PROCESSING APPARATUS AND OPERATING METHOD THEREOF	APPL	
503.30414V15	US			VACUUM PROCESSING APPARATUS AND OPERATING METHOD THEREFOR	APPL	

102.37422100 call up to file non prov app 304/10/00
 888.103780 Sr party reply to jr party app. to sr party prin. brief CIRB
 888.103780 Sr. party opposition to jr party motion exclude evidence CIRB
 503.35620000 Okada 924128 nukEop WIS6621
 500.36198400 Urano 058177 ResponEop CIRB 3/10
 503.36371100 Nanumi 116526 ResponEop WIS 3/12
 219.37088400 KAPUK 013777 ResponEop A/R500
 500.35909400 Saka 990196 ResponEop CIRB 3/12
 500.36006400 Okajima 04991 ResponEop CIRB 3/12
 017.37771100 Lu 434377 declaratioEop CIRB 3/13
 503.23333300 47911691 unanfee olcott
 512.24673400 47925444 unanfee other 6/14
 503.24757400 47927360 unanfee olcott
 503.24719400 47927442 unanfee olcott
 118.19548400 4792808 unanfee CEW
 520.24218400 4792917 unanfee olcott
 520.24321400 4792939 unanfee olcott
 500.33126002 Yano 126437 ResponEop Sem
 " " " " " Sem
 503.30414115 Kato 460433 ResponEop WIS 6/20
 " " " " " WIS 6/20
 500.35762400 Watanabe 948942 ResponEop CIRB/NEW 6/20
 " " " " " CIRB/NEW
 500.21311600 4792,476 unanfee 5/12
 500.38484400 UESAKA CALL-UPS DECLARATION/English Translation MIC ✓
 Watanabe

500.35752400 file cont app CIRB 01/12
 500.34828400 file cont app 01/12
 32400 file cont app 01/12

500.36173400 FILE CONT app CIRB/hm2 6/15

500.33126002
 33126002
 going into

500.38674400 SUZUKI E5078-01 EY New App CIRB 1/12
 500.38675400 SATOH E5239-01 ES New App CIRB 1/12

500.38654400 IMAI E5172-01 MR New App MR
 520.38615400 IGARASHI NT007205 New App MR



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

503: 30414V15

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

Issue fee 6120/00
020457 OM02/0320
ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON VA 22209

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SEP - 7 2000
TECHNOLOGY CENTER 3100

Form draws 4120/00 wis

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
09/401,433	12/16/99	015	GRAVINI, S	03/20/00
First Named Applicant	KATO, 35 USC 154(b) term ext. = 0 Days.			

ENTENTION VACUUM PROCESSING APPARATUS AND OPERATING METHOD THEREFOR

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
3	503.30414V15	034-092.000	J85 UTILITY	NO	\$1210.00	06/20/00

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
- If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

- A. Pay FEE DUE shown above, or
- B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.

All communications regarding this application must give application number and batch number.

Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.